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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/613,052

07/07/2003

Richard W. Gross

081513-329

8243

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7590

12/13/2006

MILES & STOCKBRIDGE PC  
1751 PINNACLE DRIVE  
SUITE 500  
MCLEAN, VA 22102-3833

EXAMINER

ELALLAM, AHMED

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/613,052

Applicant(s)

GROSS ET AL.

Examiner

AHMED ELALLAM

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/7/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claim 1 of this application conflict with claim 1 of Application No. 10/635,499. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

3. Claim 1 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 10/635,499. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Bremer et al, US (6,061,392).

Regarding claim 1, with reference to figures 2, 4 and 5, Bremer discloses a modem for communicating data across a wire-line in a manner that senses and dynamically adapts to the simultaneous transmission of voice information across a local loop. The modem includes an input/output signal line that is electrically connected with the local loop (e.g., plugged into an RJ-11 phone jack). The modem also includes a processor unit that is adapted for operation in one of two states: a full-band

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transmission state and a band-limited transmission state. The full-band transmission state is defined by a lower frequency boundary at a value below approximately 15-20 kilohertz and an upper frequency boundary generally greater than 40 kilohertz. The band-limited state is defined by a lower frequency boundary greater than 4 kilohertz and an upper frequency boundary greater than 40 kilohertz (which may or may not be the same as the upper frequency boundary for the full-band transmission state). The modem further includes a sensor or other sensing **means** for sensing that the local loop is in POTS mode (e.g., transmitting POTS information, or preparing to transmit POTS information), and the data signal power and bandwidth are adaptively altered to provide data without interfering with the POTS transmission. Brener also discloses that upon sensing the band-limiting condition, such as an off-hook condition, (claimed means for detecting a signaling event associated with at least a first of said bands) the **controller** causes the **processor** unit to upwardly shift the lower frequency boundary of the transmission frequency band and operate in the band-limited, or reduced-power state. (claimed means responsive to said detecting means for modifying the processing of signals transmitted over at least a second of said bands).

Likewise, upon sensing no band-limiting condition (or a cessation in the band-limiting condition), the controller causes the processor unit to downwardly shift the lower frequency boundary of the transmission frequency band, and operate in the full-band transmission state, to maximize data throughput. Bremer further discloses an apparatus for simultaneously communicating both voice and data between a customer premises and a central office across a local loop, comprising: transmitting data between the

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customer premises and the central office in a first frequency band, wherein the first frequency band is defined by an upper frequency boundary and a lower frequency boundary; (2) allocating a second frequency band for transmitting voice information between the customer premises and the central office; (3) sensing a band -limiting condition; and (4) dynamically shifting the lower frequency boundary of the first frequency band in response to the sensed band -limiting condition. In accordance with the invention, the lower frequency boundary of the first frequency band shifted to at least partially overlap the second frequency band when no band -limiting condition exists. The lower frequency boundary of the first frequency band is further shifted to avoid overlapping with any portion of the second frequency band when the band -limiting condition exists. Column 4, lines 19-67, and column 5, lines 1-3.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AHMED ELALLAM whose telephone number is (703) 308-6069. The examiner can normally be reached on 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kizou Hassan can be reached on (703) 305-4744. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

AHMED ELALLAM  
Examiner  
Art Unit 2662  
December 9, 2006

A handwritten signature in black ink, appearing to read 'Doris', with a stylized flourish at the end.

DORIS H. TO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600